

REMARKS

Applicant hereby adds claims 91-92 and cancels claims 66-68. Accordingly, claims 69-92 are pending in the present application.

Claims 66-69, 71 and 74 stand rejected under 35 U.S.C. 102(e) for anticipation by U.S. Patent No. 5,995,048 to Smithgall et al. Claims 70, 72, and 75-90 stand rejected under 35 U.S.C. 103(a) for obviousness over Smithgall.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to claim 69, it is stated on page 3 of the Office Action that Smithgall discloses the claimed encapsulant relying upon the teachings in col. 5, lines 22-25. The teachings merely state that the entire assembly is encapsulated into a non-conducting material which protects the components from the environment and also provides mechanical stability for the tag components. Smithgall fails to anticipate claim 69.

Applicant notes the requirements of MPEP §2131, which states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." This MPEP section further states that "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged

as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Claim 69 positively recites the *encapsulant comprising an **outermost planar surface of the housing***. Initially, the bald, cursory encapsulant Smithgall teachings fail to disclose the encapsulant comprising the outermost surface of the housing. Further, the teachings of Smithgall fail to disclose or suggest the outermost surface comprising a planar surface as specifically claimed. Limitations of claim 69 are not shown nor suggested by the prior art and claim 69 is allowable for at least this reason.

The claims which depend from independent claim 69 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 70 recites the *encapsulant encapsulates and **contacts the antenna***. The Office Action on page 4 states that it would have been obvious to recognize the antenna is encapsulated. Assuming argued, the Examiner's modification of the Smithgall teachings is proper, such modification fails to render claim 70 obvious. The mere encapsulation of the antenna fails to disclose or suggest the encapsulant contacting the antenna as claimed. Limitations of claim 70 are not shown nor suggested and claim 70 is allowable for at least this reason.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPO 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth *In re Lee* which were found to fail to provide the requisite motivation

to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence. In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed in *re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 70 is improper without the proper motivation and Applicants respectfully request allowance of claim 70 in the next action.

Referring to claim 73, there is no teaching or suggestion of the encapsulant contacting the integrated circuit as claimed. Claim 73 is allowable for at least this reason.

Claim 75 recites the ground plane configured to electrically couple with a terminal of the power source and provided at a voltage of the terminal. The Office Action states battery 310 provides power to the tag which means that the antenna is coupled to the IC circuitry and it would have been obvious that battery 310 is coupled to the ground plane since the tag circuitry is coupled to the antenna and the antenna is coupled to the ground plane. Smithgall fails to teach or suggest amended claim 75. The tag circuitry of Smithgall would operate to receive or transmit radio frequency energy. The transmit or reception of radio frequency energy via the antenna and the coupling of the antenna to the ground plane fails to disclose or suggest the ground plane being provided at the voltage of the terminal as claimed. Claim 75 recites limitations not shown nor suggested by the prior art and claim 75 is allowable.

The claims which depend from independent claim 75 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 79, the method defines **conductively bonding the integrated circuit with the antenna**. Smithgall fails to disclose or suggest any conductively bonding as claimed. On page 5 of the Action, it is stated that the method of claim 79 is rejected as the rejection above. However, no other claims of the "above rejection" recite conductively bonding as recited in claim 79. Further, Smithgall fails to disclose or suggest any

conductively bonding as claimed. Applicant has electronically searched the Smithgall reference and has failed to uncover any bonding teachings, let alone the specifically claimed conductively bonding of the IC and the antenna. Limitations of claim 79 are not shown nor suggested by the prior art and claim 79 is allowable.

The claims which depend from independent claim 79 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 83, it is recited that the method comprises ***printing an antenna over the ground plane in a substantially electrically insulated relationship with respect to the ground plane***. Smithgall is devoid of teaching or suggesting any printing of an antenna as claimed. The Office Action relies upon metallic plate 410 as allegedly corresponding to the claimed antenna. In no fair interpretation may *metallic plate 410* be considered to disclose or suggest printing of the claimed antenna. Applicant has electronically searched the Smithgall reference and has failed to uncover any printing teachings, let alone the specifically claimed printing of the antenna. On page 5 of the Action, it is stated that the method of claim 83 is rejected as the rejection above. However, no other claims of the "above rejection" recite printing as recited in claim 83. Further, Smithgall fails to teach or suggest forming the housing to encapsulate and ***contact the antenna*** as claimed. Limitations of claim 83 are not shown nor suggested by the prior art and claim 83 is allowable.

The claims which depend from independent claim 83 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, there is no teaching or suggestion of printing at least one conductive connection through the dielectric layer while printing the antenna as recited in claim 85. Claim 85 is allowable.

There is no teaching or suggestion of forming the housing to contact a portion of the dielectric layer as recited in claim 86. Claim 86 is allowable.

Referring to claim 88, the method recites *providing an encapsulant to form a device comprising a **substantially void-free mass***. The encapsulant teachings of Smithgall fail to disclose or suggest the claimed void-free mass. In no fair interpretation may the housing of Smithgall be considered to disclose a void-free mass as claimed. Mere encapsulation does not disclose or suggest the void-free mass. Applicants have electronically searched Smithgall and has failed to uncover any void-free teachings. On page 5 of the Action, it is stated that the method of claim 88 is rejected as the rejection above. However, no other claims of the "above rejection" recite a void-free mass as recited in claim 88. Limitations of claim 88 are not shown nor suggested by the prior art and claim 88 is allowable.

The claims which depend from independent claim 88 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, there is no teaching or suggestion of grounding the conductive layer as recited in claim 89. Claim 89 is allowable.

There is no teaching or suggestion of flowing a flowable encapsulant over the antenna and integrated circuit and curing the encapsulant as recited in claim 90. Claim 90 is allowable.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final* Action if any claims are not found to be allowable.

Applicant submits a non-initialed IDS herewith and request of initialization of the references cited on the forms PTO-1449.

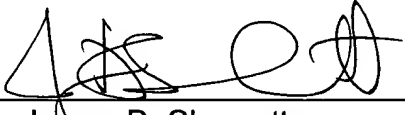
Applicant adds new claims 91-92 supported at least by Figs. 4-7 and the associated specification teachings of the present application.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 11/3/03

By: 
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